



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,625	12/20/2000	Frank Bor-Her Chen	25164-67462	9358
28863 7590 08/06/2010 SHUMAKER & SIEFFERT, P. A. 1625 RADIO DRIVE SUITE 300 WOODBURY, MN 55125			EXAMINER LIGHTFOOT, ELENA TSOY	
			ART UNIT 1715	PAPER NUMBER
			NOTIFICATION DATE 08/06/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pairedocketing@ssiplaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/742,625	<b>Applicant(s)</b> CHEN ET AL.	
	<b>Examiner</b> ELENA Tsoy LIGHTFOOT	<b>Art Unit</b> 1715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 37,51,52 and 67-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37,51,52 and 67-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Response to Amendment***

Amendment filed on June 21, 2010 has been entered. Claims 38-39 have been cancelled. Claims 37, 51-52, and 67-76 are pending in the application. Claims examined on the merits are 37, 50-52, and 67-72.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Rejection of claims 37, 50-52, and 67-72 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn due to amendment.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The phrase “**formaldehyde-free**” primer coating composition was broadly interpreted by the Examiner according to conventional meaning as a primer coating composition having no unreacted formaldehyde. It is well settled that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

4. Claims 37, 50-52, and 67-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schedlitzki (DE 2224732) in view of Cummings (US 3,529,993), further in view of Helmer et al (WO 9622338).

The cited prior art is applied here for the same reasons as set forth in the Office Action mailed on 1/20/2010. The Office Action mailed on 1/20/2010 stated that the Examiner's Answer mailed on 2/26/2009 provided two different interpretations of claimed "mat" including the current interpretation.

As to current amendment, note that **paper** carrier sheet of Schedlitzki reads on claimed *compressible mat* of claims 37, 71, 74 and 76 because:

(i) It is well known in the art that paper is made of cellulosic (**wood**) *fibers* in a resin binder composition and it is *compressible*;

(iii) Claims 37, 71, 74 and 76 **neither** recite that a compressible mat is a wood composite construction material selected from one of hardboard, medium density fiberboard, oriented strand board, particle board, or plywood; **nor** require applying a formaldehyde-free, chemically crosslinkable primer coating composition **directly** to a wood composite construction material selected from one of hardboard, medium density fiberboard, oriented strand board, particle board, or plywood, and thus, the claims do not exclude the step of applying a formaldehyde-free, chemically crosslinkable primer coating composition to a compressible mat of any kind including a compressible **paper** mat.

Therefore, a step of impregnating a *paper* carrier sheet of Schedlitzki (See page 2, paragraph 4 and page 8, line 1) with aqueous **quick**-hardening aminoplastics resins (claimed primer) (See translation, page 2, paragraphs 1-2) reads on claimed step of "applying on a surface of a compressible mat (i.e. the paper carrier sheet of Schedlitzki comprising wood fibers in a resin binder composition) a formaldehyde-free, chemically crosslinkable primer coating composition (i.e. applying the primer composition that is not carried on a paper carrier sheet)".

Art Unit: 1715

5. Claims 37, 50-52, and 67-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schedlitzki '732 in view of Cummings '993, further in view of Helmer et al '338, as applied above, and further in view of van der Hoeven (US 4,789,604) for the reasons of record set forth in the Office Action mailed on 1/20/2010.

### ***Response to Arguments***

Applicant's arguments filed June 21, 2010 have been fully considered but they are not persuasive.

Applicants request reconsideration of the rejections set forth in the Office Action dated January 20, 2010 because claims 37, 71, 74 and 76 are amended to clarify that the crosslinkable primer coating composition is applied directly to the surface of the compressible mat and it not carried on a paper carrier sheet. (See Applicants' Remarks, page 7, paragraph 3).

The Examiner maintains the rejection because claims 37, 71, 74 and 76 do not clarify that a compressible mat is a wood composite construction material selected from one of hardboard, medium density fiberboard, oriented strand board, particle board, or plywood, or claims do not require applying a formaldehyde-free, chemically crosslinkable primer coating composition directly to a wood composite construction material selected from one of hardboard, medium density fiberboard, oriented strand board, particle board, or plywood, and thus, the claims do not exclude the step of applying a formaldehyde-free, chemically crosslinkable primer coating composition to a compressible **paper** mat.

### **II. Claim Rejection Under 35 U.S.C. § 103(a)**

Claims 37-39, 50-52, and 67-76 are rejected under 35 U.S.C. 103(a) as obvious over Schedlitzki (DE 2224732; hereafter referred to as DE '732) in view of Cummings (US 3,529,993; hereafter referred to as Cummings), further in view of Helmer et al. (US WO 9622338; hereafter referred to as Helmer).

Applicants traverse the rejection because the applied references fail to disclose or suggest elimination of the primer carrier sheet. Therefore, the Office Action has not articulated a reason that one of ordinary skill in the art, following a review of DE '732 (or' any of the cited references) would eliminate the carrier sheet and select a primer composition for direct application to the compressible mat as presently claimed, In view of DE '732, one of ordinary skill in the art would have no reasonable expectation that application of that aminoplast/acrylic

Art Unit: 1715

resin directly on the surface of the compressible mat would have provided the proper surface properties (e.g., hold out), in the manufacturing process.

The Examiner respectfully disagrees with this argument for the reasons discussed above.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELENA Tsoy LIGHTFOOT whose telephone number is (571)272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

Art Unit: 1715

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy Lightfoot, Ph.D.  
Primary Examiner  
Art Unit 1715

August 3, 2010

/Elena Tsoy Lightfoot/